

## **Remarks**

### **1. Summary of the office action**

In the office action mailed July 6, 2009, (i) the Examiner rejected claim 26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, (ii) the Examiner rejected claims 34 under 35 U.S.C. § 112, second paragraph, as being indefinite, (iii) the Examiner rejected claims 1, 7-10, 12, 13, 20, 21, 23, 26-28, 31, and 33-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0049820 (Barton) in view of Official Notice, (iv) the Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Official Notice and U.S. Patent No. 5,272,525 (Borchardt), (v) the Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Barton in view of Official Notice and U.S. Patent Application Publication No. 2003/0195797 (Klug).

### **2. Amendments and status of the claims**

Applicant has cancelled claims 26 and 34, and added new claims 37 and 38. Now pending in this application are claims 1, 7-10, 12, 13, 20, 21, 23, 27-33, and 35-38. Of the pending claims, claims 1, 20, and 37 are independent.

### **3. Response to the rejections of claim 26**

The Examiner rejected claim 26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, and the Examiner rejected claim 26 under 35 U.S.C. § 103(a) as being obvious over Barton in view of Official Notice.

Applicant has cancelled claim 26. Applicant submits that the rejections of claim 26 are moot. Applicant respectfully requests that the Examiner withdraw the rejections of claim 26.

**4. Response to the rejections of claim 34**

The Examiner rejected claim 34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, and the Examiner rejected claim 34 as being obvious over Barton in view of Official Notice.

Applicant has cancelled claim 34. Applicant submits that the rejections of claim 34 are moot. Applicant respectfully requests that the Examiner withdraw the rejections of claim 34.

**5. Response to the rejection of claims 1, 7-10, 12, 13, 20, 21, 23, 24, 27, 28, 31, and 33**

The Examiner rejected claims 1, 7-10, 12, 13, 20, 21, 23, 24, 27-28, 31, and 33 under 35 U.S.C. § 103(a) as being obvious over Barton and Official Notice. Of these claims, claims 1 and 20 are independent. Applicant submits that the Examiner has not established *prima facie* obviousness of claims 1, 7-10, 12, 13, 20, 21, 23, 24, 27-28, 31, and 33, and that these claims are therefore in condition for allowance.

Applicant submits that the Examiner has not established *prima facie* obviousness of independent claims 1 and 20 because Barton and the Official Notice taken by the Examiner at page 4 of the office action do not reasonably lead to each and every limitation of claims 1 and 20. In particular, Barton and the Official Notice taken by the Examiner at page 4 of the office action do not reasonably lead to *the DVR placing the ad*

*into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR,* as recited in claims 1 and 20.

In rejecting claims 1 and 20, as well as claims 21, 27, 28, 33, 35, and 36, the Examiner stated:

Official Notice is taken that it was well known to enhance video content by including visual transitions between portions of video content. One typical video transition has been traditionally referred to as a “wipe” – much as applicant describes in his figure 3(d) and referred to as a “wipe” in the instant specification and current claims. A long time ago George Lucas used this technique heavily in the Star Wars original trilogy (1977+) whereby a first scene (first video mode) was wiped over by a second scene (second video mode). In the middle stages of the wipe, both scenes were simultaneously on the screen but without overlap.

*See, office action, page 4.*

As indicated above, the Examiner stated that a typical video transition has been traditionally referred to as a “wipe.” The Examiner then stated that the current claims refer to a “wipe.” Independent claims 1 and 20 do not just refer to a “wipe,” but actually require that the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR. Neither Barton or the Official Notice allude to such functionality.

As further indicated above, the Examiner described a video transition technique, referred to as a “wipe,” that was used by George Lucas when making the Star Wars original trilogy (1977+). According to the Examiner, in using such technique, a first scene (first video mode) was wiped over by a second scene (second video mode), and in the middle states of the wipe, both scenes were simultaneously on the screen but without overlap. As far as Applicant can tell, the first scene and the second scene that the Examiner referred to are scenes of the Star Wars original trilogy. Applicant submits that scenes of the Star Wars original trilogy do not amount to an index of programs recorded at the DVR or an advertisement (i.e., “ad”), but, at best, amount to program material that can be selected from the user interface of Barton’s DVR for playback after the DVR plays a first commercial of Barton and prior to the DVR playing a second commercial of Barton.

According to the Examiner, it is clear that Barton teaches a sequence of 1<sup>st</sup> mode (index/menu), ... advertising...2<sup>nd</sup> mode (the requested program). Even if it is assumed, for the sake of argument that a Star Wars film of the Star Wars original trilogy amounts to the requested program of Barton, Barton and the Official Notice at best disclose a sequence of 1<sup>st</sup> mode (index/menu), ... advertising...2<sup>nd</sup> mode (the Star Wars film having a video transition referred to as a “wipe”). Such disclosure of Barton and the Official Notice do not reasonably lead to *the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR*, wherein *the ad wipes across a screen of the display*

*device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claims 1 and 20.*

Since Barton and the Official Notice do not reasonably lead to each and every element recited in claims 1 and 20, Applicant submits that the Examiner has not established *prima facie* obviousness of claims 1 and 20, and that claims 1 and 20 are therefore allowable over Barton and the Official Notice. Further, without conceding the assertions made by the Examiner with respect to claims 7-10, 12, 13, 21, 23, 27, 28, 31, and 33, Applicant submits that claims 7-10, 12, 13, 21, 23, 27, 28, 31, and 33 are allowable for at least the reason that each of these claims depends from one of allowable claims 1 and 20.

#### **6. Response to the rejection of claims 29 and 30**

The Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being obvious over Barton, the Official Notice, and Borchardt. Claims 29 and 30 depend from claim 1 and necessarily include each and every element of claim 1. As stated above, Barton and the Official Notice do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claim 1. Applicant

submits that Borchardt does not make up for this deficiency of Barton and the Official Notice. Since Barton, the Official Notice, and Borchardt do not reasonably lead to each and every element of claims 29 and 30, Applicant submits that claims 29 and 30 are allowable over Barton, the Official Notice, and Borchardt.

#### **7. Response to the rejection of claim 32**

The Examiner rejected claim 32 under 35 U.S.C. § 103(a) as being obvious over Barton, the Official Notice, and Klug. Claim 32 depends from claim 1 and necessarily includes each and every element of claim 1. As stated above, Barton and Chen do not reasonably lead to the DVR placing the ad into the digital video output stream so that the digital video output stream simultaneously includes the index of programs recorded at the DVR and the ad but does not include the video of the program recorded at the DVR, wherein the ad wipes across a screen of the display device starting from a first side of the screen and ending at a second side of the screen without overlapping any portion of the index of programs recorded at the DVR or any portion of the video of the program recorded at the DVR, as recited in claim 1. Applicant submits that Klug does not make up for this deficiency of Barton and the Official Notice. Since Barton, the Official Notice, and Klug do not reasonably lead to each and every element of claim 32, Applicant submits that claim 32 is allowable over Barton, the Official Notice, and Klug.

#### **8. New claims**

Applicant has added new independent claim 37 and new dependent claim 38. Applicant submits that independent claim 37 is allowable for the same reasons listed above with respect to claims 1 and 20. Additionally, Applicant submits that claim 37 is

allowable because it recites the DVR obtaining the ad based on time information and the geographic location. Applicant submits that claim 38 is allowable for at least the reason that it depends from allowable claim 37.

## **9. Conclusion**

Applicant believes that all of the pending claims have been addressed in this response. However, failure to address a specific rejection or assertion made by the Examiner does not signify that Applicant agrees with or concedes that rejection or assertion.

For the foregoing reasons, Applicant submits that claims 1, 7-10, 12, 13, 20, 21, 23, 27-33, and 35-38 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all of the claims.

Respectfully submitted,

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